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Resp./Amdt. dated Oct. 25, 2005
Reply to Office Action of Aug. 8, 2005

Remarks/Arguments

There are no amendments to the specification, claims or the drawings herein.

In the Claims, Claims 1-25 are pending. Claims 1-25 are rejected.

Reconsideration is respectfully requested.

The Examiner contended, "[t]he title of the invention is not descriptive", and required Applicant to provide a new title, "that is clearly indicative of the invention to which the claims are directed". Applicant respectfully submits that the title is both descriptive and fully compliant with the rules and guidelines for a patent application title as set forth in 37 CFR §1.72 and as suggested by MPEP §606 *Title of Invention*. However, should the Examiner continue to insist on a new title, Applicant respectfully requests that the Examiner explain why the title is not descriptive of the claimed invention, as contended. In addition, it is respectfully requested that the Examiner suggest a new title along with the Examiner's explanation for Applicant's consideration. Applicant respectfully declines to amend the title at this time.

Reconsideration is requested.

The Examiner suggested that Applicant review the disclosure carefully, "to ensure that any and all grammatical, idiomatic, and spelling or other minor error are correct". The disclosure has been carefully reviewed, and no correction is necessary.

The Examiner rejected Claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Saft, "Unbiased battery comparison software," www.electronicstalk.com/news/saf/saf105.html, 18 February 2000, (hereinafter 'Saft'). The Examiner contended, "[t]he document discloses a computer software for recommending a battery type having, *inter alia*, programming code for sifting through all the criteria based on the use of the device by a user and recommending the appropriate battery from a plurality of batteries".

Applicant respectfully traverses the rejection on the grounds that a *prima facie* case of anticipation with respect to Saft has not been established. In particular, Applicant submits that Saft fails to disclose, explicitly or implicitly, "each element of the claim under consideration" (*W.L. Gore & Associates v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) and that Saft fails to disclose the claimed elements "arranged as in the claim" (*Lindemann Maschinenfabrik GmbH v. American Hoist &*

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Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)), as required by the Federal Circuit for *prima facie* anticipation under 35 U.S.C. 102.

Saft discloses a computer program that allows a user to “set appropriate criteria” by entering “a weighting to each of 13 selection parameters” (Saft, Page 1, Para. 2-3). The computer program, “then ranks different battery types ... according to suitability, and displays the results in graphical format for easy comparison” (Saft, Page 1, Para. 4). According to Saft, the 13 selection parameters are: (1) reliability criteria, (2) long life, (3) initial cost, (4) high performance, (5) physical size, (6) minimal water additions, (7) maintenance requirements, (8) testing requirements, (9) high temperature operation, (10) low temperature operation, (11) electrical abuse, (12) mechanical abuse, and (13) cycling (See for example, Saft Batteries, “Battery Comparison Tool,” www.saftbatteries.com/030-MS_Building/images/30-40-30_grand.jpg, (hereinafter ‘Saft Batteries’), submitted for consideration on an Information Disclosure Statement filed as a separate paper herewith). User entry consists of ranking or weighting the 13 selection criteria, wherein the weighting is based on a sliding scale ranging from “not important” to “very important” (See Saft Batteries, cited *supra*).

However, contrary to the Examiner’s contention, Saft does not disclose that recited in either of Applicant’s Claim 1 or 2. In particular, Saft at least fails to disclose or suggest, “recommending the battery type that has a constructive effect on one or both of device performance and battery performance or life *during device usage*” and “recommending is based on a use model *of the device*”, as recited in Applicant’s Claim 1 (*emphasis added*). Saft is silent on a ‘device’ in which the battery is used and thus, Saft does not and respectfully cannot disclose recommending that involves “during *device usage*” and “based on a use model of the *device*” (*emphasis added*). Similarly, Saft’s failure to disclose or suggest a ‘device’ effectively obviates disclosing that the recommended battery type is “selected from a set of battery types that is *usable with the device*”, as recited in Applicant’s Claim 2 (*emphasis added*).

Furthermore, Saft does not disclose “recommending the battery type”, as claimed by Applicant. To the contrary, the computer program of Saft merely provides an ordered or ranked list of battery types based on the user-entered weightings. The

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ranked list is displayed, "in graphical format for easy comparison" by the user (Saft, Page 1, Para. 4). As such, Saft fails to explicitly disclose "recommending the battery type" and instead leaves that up to the user based on the comparison results.

Moreover, Saft fails to disclose or suggest a "use model", as defined and claimed by Applicant (See for example, Applicant's specification, Page 2, line 19, and Page 5, lines 2-3). Applicant respectfully reminds the Examiner that, as stated in the MPEP §2173.01, "[a] fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers". Furthermore, "[w]here an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (*emphasis added*)". MPEP, 2111.01 *Plain Meaning*, Part III. Thus, the Examiner is obliged to employ Applicant's definition of claim terms when an explicit definition is provided pursuant to Applicant's right to be his/her own lexicographer. Saft clearly never discloses or suggests anything even remotely resembling Applicant's defined 'use model' of a device. In fact, the Examiner admitted as much in a rejection under U.S.C. 103(a) discussed below.

Saft at least lacks a disclosure of one or more elements recited separately in each of Applicant's Claims 1 and 2, as originally filed. In addition, Saft fails to disclose the respective claimed elements "arranged as in the claim" (*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.* cited *supra*). In fact, Applicant respectfully submits that it cannot be shown that there is essentially "no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention", as required by the Federal Circuit to support a rejection under 35 U.S.C. 102. *Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). Hence, the Examiner has failed to establish *prima facie* anticipation in view of Saft. Reconsideration and withdrawal of the rejection under 35 U.S.C. 102(b) with respect to Saft are respectfully requested for lack of evidentiary support of *prima facie* anticipation.

The Examiner rejected Claims 3-25 under U.S.C. 103(a) as being unpatentable over Saft in view of Chainer et al., U.S. Published Patent Application 2005/0043978

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(hereinafter 'Chainer et al.'). The Examiner admitted, "Saft fails to disclose its battery recommending program having an automated selection ... based on the actual usage of the device". The Examiner contended, "Chainer teaches an automated collection and dissemination of a product usage information", and concluded "[i]t would have been obvious to incorporate the program routine of Chainer into the program routine of Saft for the purpose of making the entire process automatic". The Examiner further contended, "[t]his combination [Saft combined with Chainer] would result in better, faster and more accurate recommendation of the appropriate batteries without having user's intervention" (hereinafter 'Examiner's motivation').

Applicant respectfully traverses the rejection on the grounds that the Examiner failed to establish and support with objective evidence a *prima facie* case of obviousness with respect to Saft in view of Chainer et al. In particular, to establish a *prima facie* case of obviousness, (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success in the proposed modification and combination, and that (3) the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. See MPEP, Section 2142, *Establishing a Prima Facie Case of Obviousness*. With respect to Saft in view of Chainer et al., it is respectfully submitted that the Examiner's reasons for rejecting Claims 3-25 fail to meet even the minimum requirements for establishing and maintaining *prima facie* obviousness.

As is clearly stated in the MPEP, "[o]bviousness can *only* be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation *to do so* found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" (*emphasis added*). MPEP §2143.01 *Suggestion or Motivation to Modify the References*. Furthermore, the motivation to combine must be "found in the prior art, and *not* based on applicant's disclosure". *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991) (*emphasis added*). Moreover, according to the Federal Circuit, " 'teachings of references can be combined only if there is some suggestion or incentive to do so' " (*emphasis in*

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original). *In re Fine*, 837, F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). “[E]ven when the level of skill in the art is high, the Board [or the Examiner] must identify specifically the principle, known to one of ordinary skill, which suggests the claimed combination. In other words, the Board [or the Examiner] must *explain the reasons* one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious” (*emphasis added*). *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

“[T]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art *also suggests the desirability* of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)” (*emphasis added*). MPEP §2143.01, cited *supra*. For a motivation to combine/modify to be legitimate and therefore, be employed to support a *prima facie* case of obviousness, there must be “evidence that ‘a skilled artisan, *confronted with the same problems as the inventor* and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed’”. *Ecolchem, Inc. v. Southern Calif. Edison Co.*, 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (Fed. Cir. 2000) (quoting *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)) (*emphasis is added*). Therefore, in addition to providing evidence from the prior art to support selecting and combining, the Examiner is *required* to establish and provide evidence to support the desirability of the combination in light of the problem or problems that faced *the inventor*.

Regarding Saft and Chainer et al., the Examiner’s motivation to “have incorporated the program routine of Chainer into the program routine of Saft for the purpose of making the entire process automatic” was because the combination, “would result in a better, faster and more accurate recommendation of the appropriate batteries without having user’s intervention”. Neither Saft nor Chainer et al. suggest such a motivation for the Examiner’s proposed combination. The Examiner has not and respectfully cannot point to anything in the disclosure of either Saft or Chainer et al. that indicates adding the program routine disclosed by Chainer et al. to the battery recommending program of Saft would either result in “making the entire process

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automatic" or "result in a better, faster and more accurate recommendation ... without having user's intervention". Thus, the Examiner's motivation to combine/modify Saft in view of Chainer et al. is clearly not found 'in the references themselves'.

Moreover, the Examiner provided *no extrinsic evidence to support* a contention that a teaching, suggestion, or motivation *not found explicitly* in the cited references was *either present implicitly* in that taught by the references (which in this instance, clearly it is not) *or was in the knowledge generally available to one of ordinary skill in the art*. Specifically, *the Examiner cited nothing* (i.e., no extrinsic evidence) beyond the references themselves in support of the Examiner's motivation. Therefore, the Examiner is not relying on implicit teachings or general knowledge of the skilled artisan. As such, the Examiner respectfully cannot contend that the Examiner's motivation regarding Saft and Chainer et al. are "found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art", as required by the courts to support *prima facie* obviousness. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

In addition, the Examiner's motivation lacks that necessary to qualify as a legitimate or supported motivation to combine/modify according to the courts. In particular, the Examiner offered no explanation regarding how the proposed motivation would lead the skilled artisan to select and combine the references as relied upon for the subject rejection. No explanation is presented regarding "the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them [thereby rendering] the claimed invention obvious". *In re Rouffet*, cited *supra*. In short, the Examiner's motivation fails to address *why* a skilled artisan, *without* knowledge or benefit of Applicant's teachings, would make the *specific choice* to combine Saft and Chainer et al. as opposed to some other combination of references. In addition, the Examiner's motivation provides no insight into why one skilled in the art would have found it obvious to make the particular and specific modification of the relevant teachings of Saft and Chainer et al. that the Examiner suggests. Thus, the Examiner's motivation fails to address why the skilled artisan would have been motivated to combine/modify Saft and Chainer et al.

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Moreover, the Examiner failed to establish, or for that matter, even attempt to establish, that the prior art or the skilled artisan with *no knowledge of the claimed invention* would have: (a) recognized the desirability of the combination/modification proposed by the Examiner, or (b) selected the specific elements from the cited prior art references for combination/modification, as suggested by the Examiner, when confronted with the same problem faced by the inventor. In fact, the Examiner did not explicitly or implicitly consider the problem(s) faced by the inventor as motivation for the combinations/modification proposed by the Examiner. Similarly, the Examiner has not identified specifically the principle of or explained the reasons why the skilled artisan would have been motivated to select and combine the references. *In re Rouffet*, cited *supra*. Hence, the Examiner simply has not provided a legitimate motivation to combine the cited references in support of a *prima facie* case of obviousness.

An absence of a legitimate or supported motivation to combine Saft and Chainer et al. defeats a *prima facie* case of obviousness with respect to at least Claims 3-25. Furthermore, given the lack of a supported motivation to combine the respective references, any consideration regarding what the respective combination might or might not disclose is rendered moot.

However, notwithstanding the lack of a supported motivation to combine/modify, the combination of Saft and Chainer et al. also fails to disclose or suggest *all* of the claim limitations of Claims 3-25. Applicant respectfully reminds the Examiner that, in considering the teachings of the prior art references, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Examiner does not and respectfully cannot point to specific teachings of Saft and Chainer et al., whether considered separately or together, that disclose or suggest all of the claim limitations of any or all of Claims 3-25. As such, the combination of Saft and Chainer et al. clearly fails to disclose or suggest all of the claim limitations of the claims in question, as required by the courts for establishing and supporting *prima facie* obviousness. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). A lack of such disclosure in the combined teachings similarly defeats *prima facie* obviousness. *In re Royka*, cited *supra*. As such, the rejection of Claims 3-25 with

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respect to Saft in view of Chainer et al. lacks proper evidentiary support for *prima facie* obviousness and must be withdrawn.

It is well established that, "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability" and "[i]f examination at the initial stage *does not* produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent" (*emphasis added*). *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In summary, Claims 1-25 are pending and Claims 1-25 were rejected. In light of the discussion hereinabove, Applicant respectfully submits that Claims 1-25 are in condition for allowance. Applicant respectfully requests that Claims 1-25 be allowed and that the application be passed to issue at an early date.

Should the Examiner have any questions regarding the above, please contact the undersigned, J. Michael Johnson, at telephone number (775) 849-3085.

Respectfully submitted,
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J. Michael Johnson

10/25/05
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